

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC. and
BACARDI & COMPANY LIMITED,

Petitioners,

v.

HAVANA CLUB HOLDING, S.A. and
EMPRESA CUBANA EXPORTADORA
DE ALIMENTOS Y PRODUCTOS
VARIOS, S.A., d.b.a. CUBAEXPORT,

Respondents.

05-15-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Cancellation No. 24,108

**RESPONDENT CUBAEXPORT'S REPLY BRIEF TO PETITIONERS'
RESPONSE TO RESPONDENT CUBAEXPORT'S APRIL 25, 2003 MOTION**

Pursuant to 37 C.F.R. § 2.127 and Section 502.03 of the Trademark Trial and Appeal Board ("Board") Manual of Procedure ("TBMP"), respondent Empresa Cubana Exportadora de Alimentos y Productos Varios, S.A. ("Cubaexport") hereby submits its reply brief to *Petitioners' Response To Respondent Cubaexport's Motion For An Order (1) Dismissing Bacardi's Amended Petition To Cancel; (2) In The Alternative, Directing Bacardi To Show Cause Why Its Amended Petition Should Not Be Dismissed And Compelling Disclosure Of All Ex Parte Communications; And (3) Suspending All Proceedings Pending Resolution Of This Dispositive Motion* ("Petitioners' Response"), filed May 6, 2003 by petitioners.

Petitioners argue that Cubaexport's motion should be stricken.¹

Petitioners, in support, vaguely refer to "stalling tactics" and misread the Board's April 15, 2003 order. Petitioners essentially object to the Cubaexport submission because it is captioned as a "motion," and because (they argue) Cubaexport is not allowed to present any motion, only to respond to the pending motion. This is wrong, and at best an elevation of form over substance. Petitioners have cited no valid basis for striking Cubaexport's submission.

First, the Board expressly provided in its April 15, 2003 order an opportunity for Cubaexport to be heard on the merits of the effect of petitioner Bacardi-Martini U.S.A., Inc.'s ("Bacardi") improper *ex parte* communications: "Cubaexport and petitioners are each allowed forty-five days from the mailing date of this order to file and serve a response to HCH's motion for reconsideration of the Board's order dated January 21, 2003." (Order of 4/15/03, at 3.) Cubaexport's April 25, 2003 submission was, among other things, its response to respondent Havana Club Holding, S.A.'s ("HCH") motion for reconsideration, as was made plain in Cubaexport's cover letter: "This submission is made pursuant to the Board's April 15, 2003 order allowing respondent Cubaexport to respond to the motion for reconsideration filed by Havana Club Holdings [sic], S.A." (Letter from E.Huang of Fish & Neave to Comm'r of Trademarks of 4/25/2003, attached hereto at Tab A.)

In granting Cubaexport leave to be heard on the *ex parte* communications issues, the Board recognized that the effect of *ex parte* communications is "germane" to

¹ Pursuant to TBMP § 502.03, this reply should be considered by the Board because petitioners' arguments "should be answered so as to assist the Board in arriving at a just conclusion on the motion."

petitioners' summary judgment motion under TBMP § 528.03. Accordingly, what Cubaexport has to say on those issues in its April 25, 2003 submission may not be stricken as petitioners request, particularly when petitioners will be addressing those same issues pursuant to the April 15, 2003 order.

Second, neither the Board's April 15, 2003 order nor TBMP § 528.03 can bar Cubaexport from filing its own motion seeking relief relating to Bacardi's improper *ex parte* communications in this matter. No tribunal can bar parties from making timely motions challenging the fairness of a proceeding in view of demonstrated *ex parte* communications and the likelihood of others. Moreover, due process requires that Cubaexport be allowed to be heard on the merits concerning the effect of Bacardi's *ex parte* communications. As a newly joined party, Cubaexport has the right to be heard on these issues, to seek the relief it has requested in its motion, and to preserve its rights in the event that the Board's decision is appealed.² The Board recognized this concern expressly in its April 15, 2003 order, inviting Cubaexport to respond.

Finally, although petitioners characterize Cubaexport's submission as a "stalling tactic," they do not (and cannot) explain why that is so. Far from seeking to extend the schedule set in the Board's April 15, 2003 order, Cubaexport served its

² Petitioners' suggestion that Cubaexport's response is somehow defective because the response agrees with HCH's position (Petitioners' Resp., at 1) is without merit. The Board's April 15, 2003 order granting Cubaexport leave to respond to HCH's motion obviously does not dictate the substance of Cubaexport's response.

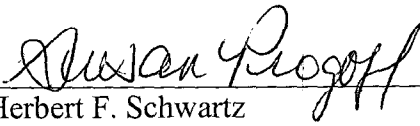
Moreover, because of a material difference in procedural posture, Cubaexport's motion is not entirely duplicative of HCH's motion. Cubaexport's motion rests squarely on dozens of documents that document flagrant, and as-yet unexplained, improper *ex parte* communications. By contrast, HCH's original motion had presented the Board with only three particular documents reflecting violations of that Act (all other documents now relied upon by Cubaexport having been unavailable to respondents when the original motion was filed).

submission on April 25, 2003, despite the fact that a response was not due until May 30, 2003 under the order. No extension is necessary here, and none is requested.³

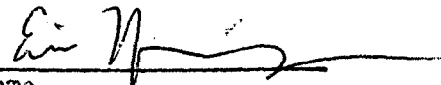
For the foregoing reasons and the reasons set forth in Cubaexport's original motion of April 25, 2003, the Board should deny petitioners' request that the April 25, 2003 motion by Cubaexport be stricken and (1) dismiss Bacardi's amended petition to cancel; (2) in the alternative, direct Bacardi to show cause why its amended petition to cancel should not be dismissed and order Bacardi to disclose fully all *ex parte* communications made between Bacardi (and/or its representatives) and PTO officials, including Director Rogan and Deputy Director Dudas; and (3) order the suspension of all other proceedings in this matter, pending the resolution of this motion.

Respectfully submitted,

Dated: May 15, 2003


Herbert F. Schwartz
Vincent N. Palladino
Susan Progoff
FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020
(212) 596-9000

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date which appears below:

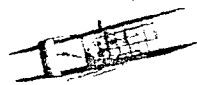

Name

May 15, 2003
Date of the Signature and Deposit

**Attorneys for Respondent,
Empresa Cubana Exportadora de
Alimentos y Productos Varios, S.A.**

³ If Bacardi had responded to the merits of HCH's motion for reconsideration, or those in Cubaexport's motion/response, briefing on this matter would be complete, and both motions be ready for disposition. Rather than address the merits, Bacardi is requesting that Cubaexport be denied the opportunity to address the *ex parte* communications issues, which the April 15, 2003 order specifically grants.

A



FISH & NEAVE

ERIC HUANG
DIRECT DIAL 212.596.9024
DIRECT FAX 646.728.2548
E-MAIL EHUANG@FISHNEAVE.COM

April 25, 2003

VIA EXPRESS MAIL

BOX TTAB
NO FEE
Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3515

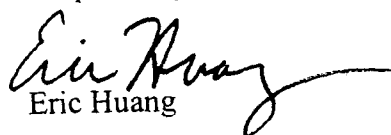
Cancellation No. 24,108:
Galleon, S.A. et al. v. Havana Club Holding, S.A. et al.

Dear Sirs:

I enclose for filing in the above proceeding *Respondent Cubaexport's Motion For An Order (1) Dismissing Bacardi's Amended Petition To Cancel; (2) In The Alternative, Directing Bacardi To Show Cause Why Its Amended Petition Should Not Be Dismissed And Compelling Disclosure Of All Ex Parte Communications; And (3) Suspending All Proceedings Pending Resolution Of This Dispositive Motion*; and the accompanying *Declaration of Eric Huang*. I also enclose a Certificate Of Service for these filings.

The enclosed submission replaces Cubaexport's submission made on April 21, 2003, which was submitted inadvertently in bound form. Other than the date signed, the content of this submission is identical to that of the April 21 submission. This submission is made pursuant to the Board's April 15, 2003 order allowing respondent Cubaexport to respond to the motion for reconsideration filed by Havana Club Holdings, S.A.

Respectfully submitted,


Eric Huang

EH:eh
Enclosures

cc: William R. Golden, Jr., Esq. (by hand w/ enclosures)
Charles S. Sims, Esq. (by hand w/ enclosures)

CERTIFICATE OF SERVICE

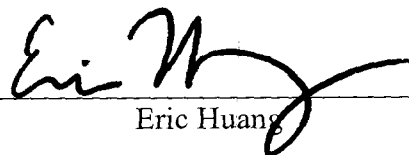
I hereby certify that on May 15, 2003, I caused *Respondent Cubaexport's Reply Brief To Petitioners' Response To Respondent Cubaexport's April 25, 2003 Motion* with the attached Exhibit A to be served on petitioners and respondent Havana Club Holding by causing a true and correct copy thereof to be delivered by hand to:

Counsel of Record for Petitioners:

William Golden, Jr.
Kelley Drye & Warren LLP
101 Park Avenue
New York, NY 10178

Counsel of Record for Respondent Havana Club Holding, S.A.

Charles Sims
Proskauer Rose LLP
1585 Broadway
New York, New York 10036


Eric Huang

TTAB



FISH & NEAVE

Herbert F. Schwartz
 Eric C. Woglom
 John E. Nathan
 Robert C. Morgan*
 Kenneth B. Herman
 Robert R. Jackson
 Jesse J. Jenner
 W. Edward Bailey
 Patricia A. Martone
 Roderick R. McKelvie***
 James F. Haley, Jr.
 Richard M. Barnes
 Laurence S. Rogers

Vincent N. Palladino
 Robert J. Goldman*
 Thomas L. Secrest
 Daniel M. Gantt
 Norman H. Beamer*
 Kevin J. Culligan
 Glenn A. Ousterhout
 Susan Prohoff
 Margaret A. Pierri
 Douglas J. Gilbert
 Denise L. Loring
 Jeffrey H. Ingberman
 Mark H. Bloomberg

Jane A. Massaro
 Duane-David Hough
 Mark D. Rowland*
 Edward J. DeFranco*
 Eric R. Hubbard
 Kelsey I. Nix
 William J. McCabe
 Marta E. Gross
 John M. Hintz
 Richard A. Inz
 Frances M. Lynch
 Christopher J. Harnett
 A. Joy Arnold

Steven Cherny
 Joseph M. Guillano
 Jeanne C. Curtis
 Gerald J. Flattmann, Jr.
 Kevin P.B. Johnson*
 Terrence J. P. Kearney*
 Robert W. Morris
 Avinash S. Lele*
 Jane T. Gunnison
 Richard L. Rainey****
 James E. Hopfenfeld**
 Pablo D. Hendler
 Brian C. Cannon*

Of Counsel

Albert E. Fey
 Kenneth A. Genoni
 Gene W. Lee

Senior Attorneys

A. Peter Adler
 Thomas J. Vetter
 Charles Quinn
 Lisa E. Cristal
 Gabrielle E. Higgins*

Frederick P. Fish 1855-1930
 Charles Neave 1867-1937

* California and New York Bars ** California Bar Only *** Delaware Bar Only **** DC Bar Only

ERIC HUANG

DIRECT DIAL 212.596.9024

DIRECT FAX 646.728.2548

E-MAIL EHUANG@FISHNEAVE.COM

05-15-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

May 15, 2003

VIA EXPRESS MAIL

BOX TTAB

NO FEE

Commissioner of Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3515

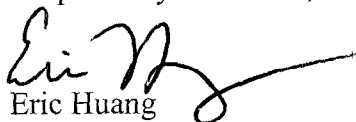
Cancellation No. 24,108:

Galleon, S.A. et al. v. Havana Club Holding, S.A. et al.

Dear Sirs:

I enclose for filing in the above proceeding *Respondent Cubaexport's Reply Brief To Petitioners' Response To Respondent Cubaexport's April 25, 2003 Motion*. I also enclose a Certificate Of Service for this filing.

Respectfully submitted,


 Eric Huang

EH:eh

Enclosures

cc: William R. Golden, Jr., Esq. (by hand w/ enclosures)
 Charles S. Sims, Esq. (by hand w/ enclosures)

1251 AVENUE OF THE AMERICAS, NEW YORK, NY 10020 TEL 212.596.9000 FAX 212.596.9090

525 UNIVERSITY AVENUE, PALO ALTO, CA 94301 TEL 650.617.4000 FAX 650.617.4090

1825 I STREET, NW, SUITE 400, WASHINGTON DC 20006 TEL 202.857.5222 FAX 202.857.5237